

reconsideration of the restrictions, as set forth below. Applicant now provisionally elects Group I, claims 1-5, and the species of esters of policosanols. Please note, however, claims 1-5 have been amended above to reflect the election of species.

TRAVERSAL AND REQUEST FOR RECONSIDERATION OF RESTRICTION:

With respect to the restriction between Groups I – VI, Applicant has elected Group I and species of esters of policosanols, in traverse. The amended claims do not show a distinct and separate invention between Groups I and II, claims 1-5 and 6-11, respectively. The inventions can no longer be shown to be distinct because the process for using the product as now claimed cannot be practiced by another materially different product, as clearly illustrated in the amended claim 6. Furthermore, the product as now claimed cannot be used in a materially different process of using that product. On that basis the restriction requirement, as between Groups I and II, should be withdrawn.

With respect to the restriction between species, Applicant contends that Rule 1.146 contemplates allowing an applicant to proceed in single application with claims that are directed to a “reasonable number of species.” The claims have been amended to include a Markush format. Restriction under 35 U.S.C. § 121 of claim in Markush format is improper. *In re Watkinson*, 900 F.2d 230, 1990 U.S. App. LEXIS 4610, 14 U.S.P.Q.2d (BNA) 1407 (Fed. Cir. 1990) (“Under *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. (BNA) 328, 332 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 464, 198 U.S.P.Q. (BNA) 334, 336 (CCPA 1978), it is *never* proper for an examiner to reject a Markush claim under 35 U.S.C. § 121. Section 121 simply does not authorize such a rejection.”).

The claims in this application are clearly in Markush format, i.e., with respect to the substances to be used in the treatment thereof, and do not represent an unreasonable number of species, and on that basis the restriction requirement, as between species, should be withdrawn.

Therefore, it is requested that the Examiner reconsider BOTH of the restriction requirements of the previous office action in this case.

In the event that any additional fees are required for purposes of filing this response, you are hereby authorized to deduct from the Deposit Account of Baker & McKenzie, No. 02-0400, any fees which may be required. *When identifying such a withdrawal, please use the Attorney Docket Number listed in the upper right-hand corner of the front page of this document.*

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Respectfully Submitted,



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